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DEC 04 2002

OFFICE OF PETITIONS

In re Application of :
Steinberg, Sherrer, Duartartas, and :
Schinazi : DECISION REFUSING STATUS
Application No. 10/037,971 : UNDER 37 CFR 1.47(a)
Filed: 24 October, 2001 :
Atty Docket No. ACT141P (11671003) :

This is in response to the renewed petition filed under 37 CFR 1.47(a) on 25 November, 2002.

The petition is again **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.
FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The renewed petition is accompanied by a declaration signed by previously non-signing joint inventor Steinberg in which the inventor has written on the declaration "I am not the first inventor, Rob Schinazi is the first inventor, I think," as well as a declaration signed by joint inventor Schinazi naming Schinazi as the sole inventor.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the

application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (2). An oath or declaration in compliance with 37 CFR 1.63 and 1.67 in that the declaration signed by joint inventor Schinazi does not list the correct inventive entity but rather lists Schinazi as the sole inventor. Additionally, the declaration signed by joint inventor Steinberg is defective in that it contains non-initialed and/or non-dated alterations.¹ A new oath or declaration in compliance with 37 CFR 1.63 and 1.67 signed by all of the signing inventors is required.

Further, in regards to joint inventor Steinberg's contention that he is not the first inventor, the order names of joint patentees in the heading of the patent is taken from the order in which the typewritten names appear in the original oath or declaration.² Since the particular order in which the names appear is of no consequence insofar as the legal rights of the joint applicants are concerned, no changes will be made except when a petition under 37 CFR 1.182 is granted. Therefore, if petitioners desire that the order of names be other than as specified on the declaration filed with the application, a petition under 37 CFR 1.182 to change the order of inventors must be filed, accompanied by the requisite petition fee.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

¹See 37 CFR 1.52(c).

²MPEP 605.04(f).

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries related to this decision should be directed
to the undersigned at 703-308-6918.

A handwritten signature in cursive script, appearing to read "D Wood".

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy